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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/552,743 04/18/00 JACKSON

R 99.198

EXAMINER
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QM12/0801

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PELLEGRINO, B	
ART UNIT	PAPER NUMBER

3738  
DATE MAILED:

08/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/552,743

Applicant(s)

Roger Jackson

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 2, 5, 7-10, 14-20, 22-24, 26, 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 11-13, 21, 25, 27 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Species III in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Since applicant has not indicated that the various embodiments are just obvious variants and the species are not patentably distinct, the restriction is being maintained. Thus, claims 2, 5, 7-10, 18-20, 22-24, 28, 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Additionally, the limitation of the cap having "upper and lower surfaces..." does not read on the elected species, thus claims 14-17 and 26 are withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3, 4, 6, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lahille et al. (5554191). Fig. 15 shows an implant having a pair of legs (31, 32)

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interconnected by wall 33. The device also has a wedge member 37 or "cap" positioned between the free ends of the legs. It can also be seen that there is a fastener 36 engaged between the wall and wedge member. The "cage member" also includes an interior chamber 341 and a plurality of apertures 35 (shown in Fig. 6) on each leg member, col. 7, lines 26-27.

Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Pisharodi (5693100). Figs. 5 and 6 show a spinal implant having an expansion member 34 coupled to another part of implant 36. The device has a rear wall and cover assembly 33 with upper and lower surfaces. It can be seen a bolt 42 is fixedly coupled with rear wall and secured to cover with a nut 40.

Claims 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Koros et al. (5980522). Fig. 12 shows an implant body 350 having a plurality of apertures 363, 361 and a chamber 358. The device contains an expansion member 450 and a cover assembly 390. Fig. 16 shows a fastener mechanism.

Claims 1, 3, 4, 6, 21, 25, 27, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Nolan (6117174). Nolan discloses a spinal fusion device having an expansion cap 14', Figs. 12, 13, 17. Fig. 18 shows the cage device can be threaded and Fig. 16 shows the implanted device being cylindrical. Regarding claims 1 and 4, see Fig. 15, fastener 98. With respect to method claim 21, see col. 5, lines 22-31, col. 6, lines 59-63 and col. 7, lines 2-8, Fig. 17.

Claims 21, 25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Chauvin et al. (6129763). Chauvin et al. disclose a spinal implant is used to fuse

adjacent vertebrae, col. 3, lines 21-30. It can be seen (Fig. 1) that the cylindrical, threaded implant 1 is provided with a cap 2. Chauvin et al. also disclose the "cap" expands the implant, col. 4, line 48. Chauvin et al. additionally disclose the "cap" is then coupled to the implant by using a plug 3, col. 5, lines 57-59.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vaccaro (6102950) show an expandable fusion device with a shaft used to expand the members.

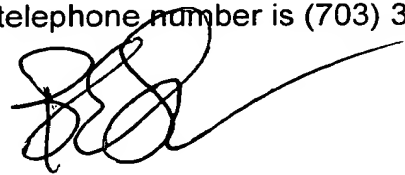
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino

July 23, 2001

TC 3700, AU 3738



Bruce Snow

Primary Examiner

